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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/270,006	03/16/1999	JEAN-PIERRE ROBIN	017753-113	1899

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/270,006

Applicant(s)

ROBIN ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 102-114 is/are pending in the application.
- 4a) Of the above claim(s) 113 and 114 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 108-112 is/are allowed.
- 6) ☒ Claim(s) 102, 104 and 105 is/are rejected.
- 7) ☒ Claim(s) 103, 106 and 107 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicants' response, which included cancellation of claims 88-101 and addition of new claims 102-114, filed on 5/30/2003, is made of record.

Claims 102-114 are now pending.

In view of applicants' response, the following apply.

Newly submitted claims 113-114 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: First of all, applicants should note that the originally presented claims 1-87 were subjected to restriction requirement and applicants elected claims 59-71 for examination in paper # 8. Subsequently, in paper # 12, applicants cancelled claims 1-87 and added claims 88-102 belonging to the elected subject matter. In the last office action, paper # 29, these claims were examined. The newly presented compound claims 113-114 related to non-elected subject and were not presented originally and would have been subjected to restriction requirement of paper # 5.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 113-114 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

In view of applicants' response, all 112 first, second paragraph rejections, 102 rejections and 103 rejections made in the previous office action have been obviated.

As for new claims 102-112, the following rejections apply.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 102 and 104-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemmens et al. Journal of Organic Chemistry, 49: 2231-2235, 1984.

Lemmens et al teaches several glycidic esters generically embraced by the instant claims. See entire document especially Scheme I and Table I for compounds made. Note the proviso in claim 102 does not exclude compounds 4g and 4j shown in the Table I on page 2232.

Claim 102 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. Journal of Organic Chemistry, 47: 2231-2235, 1984.

Johnson et al teaches several glycidic esters generically embraced by the instant claims. See entire document especially Scheme on page 1206 and Table I, second compound. Note the proviso in claim 102 does not exclude this compound.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 102 and 104-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. Organic Reactions Volume V, 414-439, 1949.

Newman et al teaches several glycidic esters generically embraced by the instant claims. See entire document especially Table I for compounds made. Particularly note R', R'', and R''' includes phenyl, H, methyl and ethyl. Note the proviso in claim 102 does not exclude all compounds shown in the Table I.

Instant claims differ from the reference in requiring free acid while reference compounds are esters.

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However, Newman et al teaches hydrolysis of esters to acids on page 421-422. Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make variously substituted glycidic compounds and hydrolyze them to free acid as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

Claims 102 and 104-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawata et al. US 4,619,88

Kawata et al teaches several glycidic esters generically embraced by the instant claims. See entire document especially see formula I on column 1-2 and note the definition of  $R^1$ ,  $R^2$ , and  $R^3$ , which generically include compounds claimed in the instant claims useful light sensitive material. See column 5-7 for various epoxy acids and column 8 for process for making.

Kawata et al., differs from the instant claims in not exemplifying all compounds claimed. But Kawata et al. teaches equivalency of the exemplified compounds with those claimed.

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make variously substituted glycidic compounds and hydrolyze them to free acid as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

***Allowable Subject Matter***

Claims 108-112 are allowed and claims 103, 106-107 are objected to as being dependent upon a rejected base claim, but would be allowable, barring any finding of prior art in a subsequent search, if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Said claims would be allowed since specific species embraced in these claims are not taught or suggested by the art of record or from a search in the relevant art area.

This office action is not made Final.

***Conclusion***

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

*V. Balasubramanian*  
Venkataraman Balasubramanian

8/22/2003